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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/715,164 | 11/17/2003 | Richard Watson | 80337.00010 | 4106 |
| 32584 | 7590 | 03/28/2006 | EXAMINER | |
| LOEFFLER JONAS & TUGGEY, LLP 755 EAST MULBERRY STREET SUITE 200 SAN ANTONIO, TX 78212 | | | BOGART, MICHAEL G | |
| | | ART UNIT | PAPER NUMBER | |
| | | 3761 | | |

DATE MAILED: 03/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|-------------------|-----------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/715,164 | WATSON, RICHARD |
| | Examiner | Art Unit |
| | Michael G. Bogart | 3761 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 21 November 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 21-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 21-28 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 17 November 2003 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Terminal Disclaimer

The terminal disclaimer filed on 21 November 2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US 6,648,862 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21-25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Skalla (US 5,522,808 A).

Regarding claim 21, Skalla teaches a personally portable vacuum desiccator (2) comprising:

a chamber (6) having a trapping agent (96)(col. 8, lines 42-49);

a vacuum pump member (50) in gas/liquid communication (52) with the outlet port of the chamber (6);

a motor operably connected to said vacuum pump (50)(figure 1)(col. 7, lines 53-65, incorporating by reference, Ametek Model No. 116763-13, which is an electrical motor powered

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vacuum, as a representative vacuum unit (see Ametek Product Bulletin for Model 116763-13);
and

a tube (10) in gas/liquid flow communication with said chamber (6);

said tube (10) being positionable in gas/liquid flow communication with a wound or
incision on a user;

the vacuum desiccator (2) being transportable (figure 1);

said vacuum pump (50) being operable to draw fluid from the wound or incision through
said tube (10) and into said chamber (6);

said trapping agent (96) having a capability of trapping a volume of the fluid.

Skalla thus teaches the claimed invention except for the desiccator being transportable *on*
a user's person.

Absent an unexpected result, making what is known in the prior art portable, can not
patentably distinguish an invention over the prior art. *In re Lindberg*, 194 F.2d 732, 93 USPQ 23
(CCPA 1952) (Fact that a claimed device is portable or movable is not sufficient by itself to
patentably distinguish over an otherwise old device unless there are new or unexpected results.).
MPEP § 2144.04 (V).

Regarding claim 22, Skalla teaches a trapping agent that is a desiccant (col. 8, lines 42-
49).

Regarding claim 23, Skalla teaches a tube (10) comprising a single passage gal/liquid
flow path.

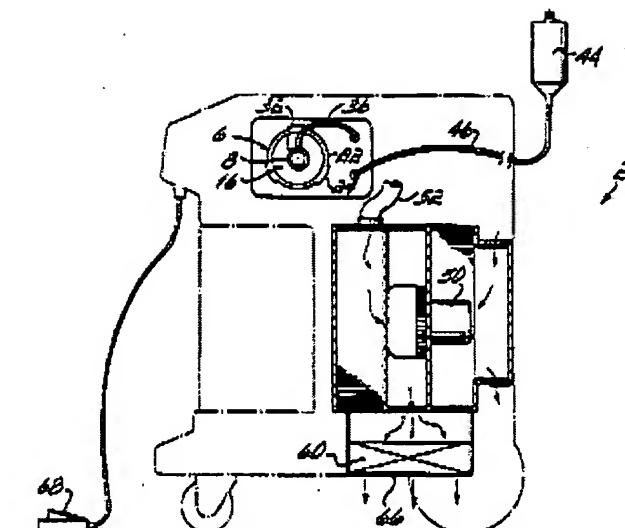


FIG. 1

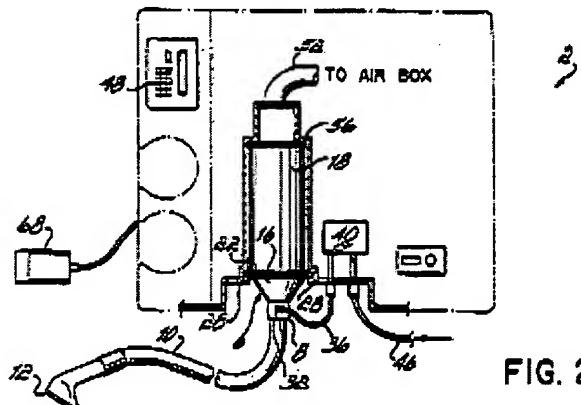


FIG. 2

Regarding claim 24, Skalla teaches a trapping agent (96) disposed in a removable cartridge (16, 18).

Regarding claim 25, Skalla teaches a control circuit (48, 68) which controls the motor and pump (50)(col. 8, lines 1-7).

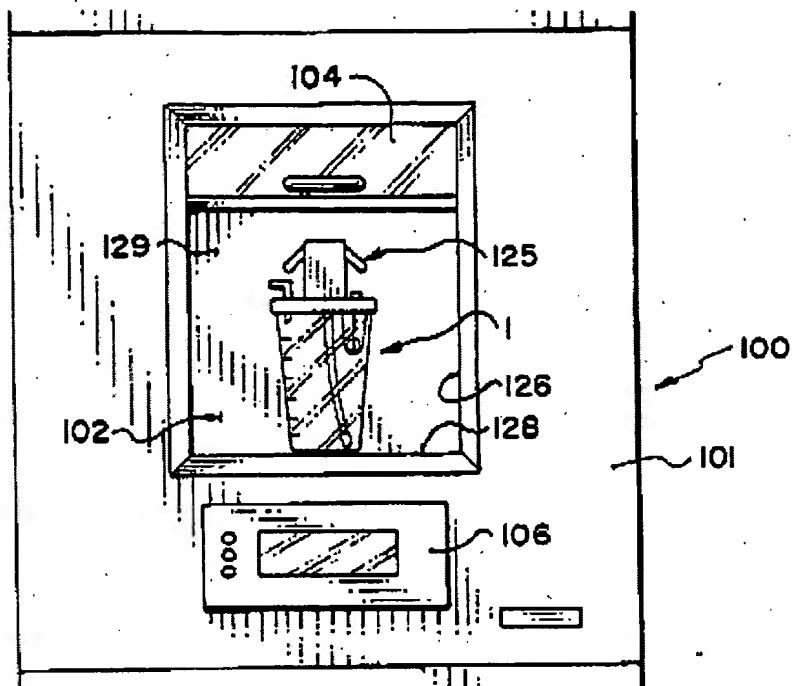
Claims 26 and 27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Skalla as applied to claims 1-25 above, and further in view of Lichtenstein (US 4,464,172).

Lichtenstein teaches an automated medical care system that employs a pressure sensor (PS2) and an I/O circuit (101). At the time of the invention, it would have been obvious to one of ordinary skill in the art to add these elements to the device of Skalla in order to automate its functions. See *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) (Appellant argued that claims to a permanent mold casting apparatus for molding trunk pistons were allowable over the prior art because the claimed invention combined "old permanent-mold structures together with a timer and solenoid which automatically actuates the known pressure valve system to release the inner core after a predetermined time has elapsed." The court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art.). MPEP § 2144.04 (III).

Claim 28 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Skalla as applied to claims 1-25 above, and further in view of Walker (US 5,741,237 A).

Skalla fails to claim a limitation where the chamber is transparent. Walker teaches that it is known in the art to use transparent canisters (1) for containing such material in order to visually inspect its content without opening the device (fig. 2).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to add the transparent feature of Walker to the device of Skalla in order to allow such a person to visibly see the interior of the device.



Response to Arguments

Applicant's arguments filed 21 November 2005 have been fully considered but they are not persuasive.

Applicant asserts that Skalla does not teach or suggest a personally portable vacuum desiccator. This argument is not persuasive because Skalla teaches a "personally portable" cart mounted apparatus. What Skalla fails to teach is the device being transportable upon a user's person, i.e., a device small enough and shaped to be carried around. Applicant is directed to *In re Lindberg*, supra, which states that making what is known in the art portable is not sufficient to patentably distinguish over the prior art device absent a new or unexpected result. Applicant has not asserted any unexpected result based on making the device of Skalla more readily portable.

Regarding claims 21, 23 and 24, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which

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applicant relies (i.e., that the claimed invention collects liquids in addition to, or instead of gases) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding claims 21, 23 and 24, in further response to applicant's argument that the instant invention is "for collecting excess liquid", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The device of Skalla is capable of collecting at least small amounts of moisture in liquid form.

Regarding claim 22, applicant asserts that Skalla does not teach the group of trapping agents. This argument is not persuasive because Skalla teaches a dessicant (col. 8, lines 42-48), which is a member of the group. A species will anticipate a claim to a genus. "A generic claim cannot be allowed to an applicant if the prior art discloses a species falling within the claimed genus." When the species is clearly named, the species claim is anticipated no matter how many other species are additionally named. *Ex parte A*, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5

USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Lichtenstein provides an automatic or mechanical means for accomplishing a varied array of medical activities. As cited supra, *In re Venner* established that broadly providing automatic or mechanical means to replace a manual activity is not sufficient to distinguish over the prior art. One of ordinary skill in the art would have recognized Lichtenstein's broad teaching of automating medical activities and would have been motivated to apply them to the device of Skalla in order to save time and manpower during use of the device.

Regarding claim 26, Lichtenstein teaches a pressure sensor (PS2)(col. 14, line 2) which is included in the instantly claimed group, see *Ex parte A*, supra.

Further regarding claim 26, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a group of sensors within the dessicator unit) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, Supra.

In response to applicant's argument that Walker does not teach a canister with a transparent material, the device being directed a fluid disposal, not collection, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Walker clearly teaches a transparent canister (1)(fig. 2)(col. 4, lines 25-38) as is well known in the art. The purpose of the canister is not relevant, it is applied as a secondary reference that teaches a transparent container only. This transparency enables a visual check of the canister's interior.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bogart whose telephone number is (571) 272-4933.

In the event the examiner is not available, the Examiner's supervisor, Tatyana Zalukaeva may be reached at phone number (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300 for formal communications. For informal communications, the direct fax to the Examiner is (571) 273-4933.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-3700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Michael Bogart
6 February 2006